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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,436	10/31/2003	Shinichi Ito	04329.2437-02	7730
22852	7590	07/22/2005	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			BAREFORD, KATHERINE A	
		ART UNIT	PAPER NUMBER	
		1762		

DATE MAILED: 07/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/697,436	ITO, SHINICHI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Katherine A. Bareford	1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 June 2005.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 11-13 and 18-24 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 15-17 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/05</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

1. The amendment of June 16, 2005 has been received and entered.

Claims 11-13 and 18-24 remain withdrawn as drawn to a non-elected invention.

Claims 1-10 and 14 are canceled.

Claims 15-17 are pending for examination.

### *Specification*

2. The objection to the disclosure because of informalities is withdrawn as the first paragraph of the application has been amended to clarify that application 10/144,028 is now U.S. Patent No. 6,669,982 by the amendment of June 16, 2005.

### *Claim Rejections - 35 USC § 112*

3. The objection to claims 15-17 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement is withdrawn due to applicant's amendment of June 16, 2005 to remove that the relative movement can be spiral movement.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 15-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15, lines 20-21, "a distance between a dropping start position and the adjacent edge of the substrate" is vague and indefinite as worded because it is unclear what "edge" of the substrate would be "the adjacent edge". The substrate would have various edge areas, as shown in figure 23 of the specification, which shows left and right edges and also north and south edges. Also, distance could be measured in the "file" direction or the "rank" direction, for example, or at an angle. While "rank direction" is referred to in line 22, it is unclear from the wording if the first distance of lines 20-21 is measured in this direction. If by "adjacent edge" applicant means the edge closest to the dropping start position, applicant should so clarify.

Claim 15, lines 21-22, "a distance between a dropping end position and the adjacent edge of the substrate along the rank direction" is vague and indefinite as worded. The substrate would have various edge areas, as shown in figure 23 of the specification, which shows left and right edges and also north and south edges. Also, distance could be measured in the "file" direction or the "rank" direction, for example, or at an angle. While "rank direction" is referred to in line 22, it is unclear from the wording if the second distance of lines 21-22 is measured in this direction. Furthermore, "the adjacent edge" of lines 21-22 seems to refer back to "the adjacent edge" of line 20, thus indicating that both the first and second distances are measured

from the same "adjacent edge" area. If by "the adjacent edge" at lines 21-22, applicant actually means the edge closest to the dropping end position, applicant should so clarify.

Claim 15, line 22-24, "the distance between a liquid film and the adjacent edge of the substrate along the file direction is set so as to gradually become smaller from the dropping start portion to the dropping end position" is vague and indefinite as worded. (1) First, it is unclear where measurement points of "the liquid film" would start. Does applicant mean to measure from "an end of the liquid film along the file direction" as originally worded in the claims? (2) As to measuring to "the adjacent edge", the substrate would have various edge areas, as shown in figure 23 of the specification, which shows left and right edges and also north and south edges. Also, distance could be measured in the "file" direction or the "rank" direction, for example, or at an angle. While "file direction" is referred to in line 23, it is unclear from the wording if the third distance of line 22 is measured in this direction. Furthermore, "the adjacent edge" of line 23 seems to refer back to "the adjacent edge" of line 20, thus indicating that both the first and third distances are measured from the same "adjacent edge" area. If by "the adjacent edge" at line 23, applicant actually means the edge closest to the liquid film end position, applicant should so clarify.

Claim 15, lines 20-24, this section describes distance relationships, which as described in the specification and at Figures 16 and 23, appear to require that all of the application of coating occurs on the substrate, with an edge area of the substrate that is

not coated. However, from the wording of the claim, it appears that the dropping point, etc. could occur outside of the substrate, so that during the coating the entire substrate is covered. It is unclear how the invention would work if this is the case.

The other dependent claims do not cure the defects of the claims from which they depend.

### *Double Patenting*

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 15-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15-17 of copending Application No. 10/697,260. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 15-17 of

10/697,260 provide all the features of claims 15-17 of the present invention, and can have other features as well, such as possible spiral movement when applying the liquid.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. The double patenting rejection of claims 15-17 over claims 15-17 of 10/697,260 has been changed from a statutory double patenting rejection to an obvious double patenting rejection due to applicant's amendments to the claims.

#### *Response to Arguments*

9. Applicant's arguments with respect to claims 15-17 have been considered but are moot in view of the new ground(s) of rejection.

10. (1) as to the 35 USC 112 rejections above, these are due to the amendments to the claims. (2) as to the double patenting rejection of claims 15-17, the rejection using 10/697,260 has been changed from a statutory double patenting rejection to an obvious double patenting rejection due to applicant's amendments to the claims.

#### *Conclusion*

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine A. Bareford whose telephone number is (571) 272-1413. The examiner can normally be reached on M-F(6:00-3:30) with the First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-1423. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and for After Final communications.

Other inquiries can be directed to the Tech Center 1700 telephone number at (571) 272-1700.

Furthermore, information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Kathleen B. Barford*  
KATHERINE BARFORD  
PRIMARY EXAMINER